

Application No. : 09/825,772
Amdt. Dated : August 13, 2008
Reply To O.A. Of : February 13, 2008

REMARKS

By way of summary, Claims 30-45 and 55-60 were pending in this application. In the present amendment, the Applicant amended Claims 30 and 55 to comply with currently understood new training related to method claims and the Patent Office's interpretation of Section 101 jurisprudence.

Accordingly, Claims 30-45 and 55-60 remain pending for consideration.

Comments on Office Action of February 12, 2008

The Applicant is disappointed with the content and analysis of the Patent Office to date in the present application. For example, the Present Office Action begins by stating that the Applicant's arguments in prior correspondence are moot in light of new grounds of rejection. See *Pg. 2 Para. No. 2*. This phrase is normally used when an Examiner is no longer sustaining prior rejections. However, in the Present Office Action, the Examiner maintains Section 102 rejections that have been present through now two (for Carpenter) and three (for Yost) Office Actions.

Additionally, in prior responses, the Applicant attempted to recite claim limitations not taught or suggested by the Carpenter and Yost references. The Applicant repeatedly reminded the Examiner that Section 102 rejections require an identity of teachings of the claim elements by the references cited. In response, the Applicant received the Present Office Action alleging that the Carpenter and Yost patents teach method steps different than those pending in the present application! Thus, the Present Office Action is full of recited teachings not the same as the presently pending claims. And, this is not the first Action in the present application where allegations are made against method steps not found in the then-pending claim elements.

The Applicant refused and continues to refuse to argue whether or not method steps different from those currently pending are taught or suggested by the Carpenter and Yost patents, and instead the Applicant argued and continues to maintain that the Carpenter and Yost, alone or together, in no way anticipate the actual presently pending claim elements. Applicant respectfully requests that any future rejection based

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prior art, including the Carpenter or Yost references, explicitly show where the Office finds the necessary identical teaching for each actual recited claim element as required (see MPEP 2131 discussing the requirements for a *prima facie* case of anticipation).

The Applicant is also confused by the organization in the present Office Action. For example, the allegations alleging that the Carpenter patent identically teaches the presently pending claim elements requires one page of "Response to Applicant's Arguments" (see pages 2-3) and three pages of repeat rejections (see pages 11-13); again, none of which actually reference the claim elements presently pending. Moreover, the allegations alleging that the Yost patent identically teaches the presently pending claim elements requires three pages of "Response to Applicant's Arguments" (see pages 3-5) and five pages of repeat rejections (see pages 6-10). Similar to Carpenter, none of the allegations of Yost actually reference the claim elements presently pending. A *prima facie* case of anticipation has simply not been made.

In short, the Applicant submits these comments with the hope that a speedy and fair resolution can be achieved with respect to the Presently Pending Application. This Application has been in prosecution for 2 years at great expense to the Applicant. The Applicant would be happy to discuss the merits of this case in a telephonic interview with the Examiner and/or the Examiner's Supervisor if such an interview might lead to a resolution of the Presently Pending Application.

Rejection Of Claims 30-45 and 55-58 Under 35 U.S.C. § 102(e) Over Yost

The Office Action rejected Claims 30-45 and 55-58 under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,154,766, issued to Yost et al. (the Yost patent). The Applicant respectfully traverses this rejection because the Yost patent fails to identically teach every element of the claim. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim).

For example, independent Claims 30 and 55 each recite a method where a consumer subscribes to receive specific information about specific products. In a world

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of consumer advertisement overload, consumers mostly ignore junk email or other communications from advertisers or product manufactures. In fact, many consumers simply filter such email out and never review it. In the present innovation, product suppliers cannot simply choose to push information it wants to the consumer. Rather, the present novel disclosure relates to providing that information approved by the consumer. For example, a consumer may constrain information through the sub-product information filters. For example, a consumer might choose to subscribe to a service that produces an email to the consumer if, and only if, a Sony 60 inch WEGA™ Rear Projection HDTV television drops into a consumer selected price-point range from a consumer selected dealer within a consumer selected zip code or area.

In direct contrast, the Yost patent is solving a fundamentally different problem and lacks a teaching of the actual presently pending claims. The Yost patent is concerned with providing certain subsets of business statistics from a data warehouse of business information to business managers desiring the subsets. Yost is not providing a commercial product for purchase by a retail consumer; rather it is giving business personnel customizable reports from data related to the personnel's business. See for example, Col. 8:1-5 stating:

For example, if a service were specified to run the monthly sales totals for the Midwest region of a company every weekend and generate an alert to the supervisor on Monday morning if sales drop below 5%, then service generation module 46 would be responsible to monitor the schedule of this service to ensure that the report contained therein was processed over the weekend and then generate an alert report if the criteria set in the service is satisfied.

Any "service" alleged by Yost is simply a business data statistics report. For example, Col. 4:11 – 15 states:

A "service" as used herein should be understood to include one or more reports that are scheduled to be run against one or more data warehouses, relational databases, files in a directory, information from a web or file transfer protocol site, or information provided by a custom module, by a server system.

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Accordingly, the Yost patent fails to identically teach or suggest each element of independent Claims 30 and 55. Thus, the Applicant respectfully submits that independent Claims 30 and 55 are allowable over the Yost patent. Similarly, dependent Claims 31-45 and 56-60, which dependent from Claims 30 and 55, are allowable over the Yost patent because of their dependency and because of the additional elements recited therein. For example, Claim 35 recites use of a barcode reader to customize the deliverable, Claim 37 recites dynamic consumer information and Claim 41 recites that the deliverables include email.

Rejection Of Claims 30-45 and 55-60 Under 35 U.S.C. § 102(e) Over Carpenter

The Office Action rejected Claims 30-45 and 55-60 under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,065,047, issued to Carpenter et al. (the Carpenter patent). The Applicant respectfully traverses this rejection because the Carpenter patent fails to identically teach every element of the claim.

As discussed, independent Claims 30 and 55 each claim user/consumer selection of a product followed by subscription to specific subject areas related to that product in order to narrowly define the permissibility of information a system can push to the user's email.

In contrast, the Carpenter patent discloses the CompuServe's Easy Navigator User Interface, which much like an AOL or Yahoo.com website front end, is simply a user interface environment for online activity. The interaction between a user and a front-end website like Yahoo or AOL is fundamentally different that the presently claimed subscription based deliverables. In Carpenter, the user is subscribing to a website, e.g., CompuServe's Easy Navigator. Upon subscription (monthly payments to CompuServe), the user can enter information and more information from the website is served, whether from a "store," or a "chat," or the like. While the present application's subscription service directs consumers to subscribe not to a website, but to a certain narrow subsets of product information, so that, for example, when the commercial market meets these subscription parameters, information can be provided. Thus, there is a distinct and patentable difference between a subscription service that only notifies a

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user when a certain product meets the limitations to which the consumer subscribed, e.g., price, location, brand, delivery time, etc, and a common interaction between a user and a "store" website to bring up information on any product offering in the "store."

See for example, Col. 6:1 – 18 of the Carpenter patent, stating:

For example, if the subscriber has selected "money" as a topic, "budgeting" as a subtopic, and the selected action is "chat," the subscriber may enter a chat content area related to money/budgeting. Once at the chat area, the subscriber may join a chat session and begin monitoring the remarks and comments of other subscribers as well as submit messages to be displayed to the other subscribers participating in the chat session. If the selected action is "shopping," the subscriber may enter an electronic mall area in which products and services related to money/budgeting are presented. The subscriber may browse the offerings in the mall and make online purchases if desired. Other actions available to the subscriber in the specific content area may allow the subscriber to perform other sets of tasks in which the information presented to and/or exchanged with other subscribers, merchants, etc. relates to the selected topic and subtopic.

Thus, the Carpenter patent also fails to teach or suggest narrow consumer subscription to products or services. Accordingly, the Carpenter patent fails to identically teach or suggest each element of independent Claims 30 and 55. Thus, the Applicant respectfully submits that independent Claims 30 and 55 are allowable over the Carpenter patent. Similarly, dependent Claims 31-45 and 56-60, which dependent from Claims 30 and 55, are allowable over the Carpenter patent because of their dependency and because of the additional elements recited therein.

Request For Telephone Interview

In view of the forgoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Applicant's attorney of record hereby formally requests a telephone interview with the Examiner. The Applicant's attorney can be reached at (949) 721-2946.

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No Disclaimers or Disavowals

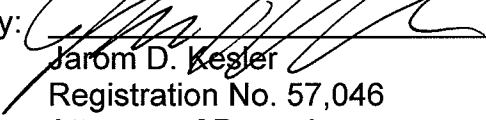
Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

In addition, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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